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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/980,816	02/05/2002	Nobuo Shiraishi	81833.0031	1572
26021	7590	07/15/2004	EXAMINER	
HOGAN & HARTSON L.L.P. 500 S. GRAND AVENUE SUITE 1900 LOS ANGELES, CA 90071-2611			HUYNH, LOUIS K	
			ART UNIT	PAPER NUMBER
			3721	

DATE MAILED: 07/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/980,816

Applicant(s)

SHIRAISHI ET AL.

Examiner

Louis K. Huynh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4,6 and 22-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4,6 and 22-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>05282004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 28, 2004 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 4 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not disclose and/or teach a step of “cutting the mount *on the plurality of concave portions* to obtain a cut piece as a cosmetic material sheet.”

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 4 and 22-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 4, line 12: “cutting the mount between or *on the plurality of concave portions*” renders the claim indefinite because it includes the step of cutting the mount on the plurality of concave portions which is not supported in the specification and would render the cut piece as an unusable cosmetic material sheet.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4, 6 and 22-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muchin (US 5,161,688) in view of Gueret (US 4,962,627); and further in view of Matsos et al. (US 6,190,730).

With respect to Claims 4 and 6, Muchin discloses a method and apparatus for manufacturing a cosmetic material sheet including: supplying a mount (52) having a plurality of concave portions (74) formed on an upper surface with suitable punch (59) (col. 5, lines 55-65); filling powdery cosmetic material (75) on the upper surface of the mount (52) with a filling device (squeegee-like tool 77); clearing the upper surface of the mount by removing a backing ply (56) along with any residue (79) with an inherent removing device (col. 6, lines 15-24; FIG. 3f); adhering lamination material (70) to the upper surface of the mount (52) with an inherent laminating device; and cutting the mount between the plurality of concave portions (74) (col. 6, lines 34-36; FIG. 3f) with a cutting tool (88) to obtain a cut piece (10) as a cosmetic material sheet. The method and apparatus of Muchin meet all of applicant's claimed subject matter but

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lack the specific teaching of a step of pressing the filled powdery cosmetic material and a pressing device for pressing the filled powdery cosmetic material.

However, powdery cosmetic material, such as makeup powder, are known to be sold in compact form, and Gueret discloses a method for producing cosmetic compact products from cosmetic powdery material wherein a quantity of cosmetic powdery material is pressed to form a compact product prior to being packaged.

Therefore, it would have been obvious to a person with an ordinary skill in the art, at the time the invention was made, to have modified the method of Muchin by having provided a pressing device for pressing the filled powdery cosmetic material, as taught by Gueret, in order to form a cosmetic sampler comprising cosmetic powdery material in a compact form that resemble the product to be sold.

The modified method and apparatus of Muchin in view of Gueret meets all of applicant's claimed subject matter but lacks the specific teaching of the lamination material comprising a window portion that is smaller than the powdery cosmetic adhering layer.

Matsos discloses a method and apparatus for forming a sheet of cosmetic sampler wherein the sampler includes a transparent cover film (4), onto which a sample of cosmetic product (2) is printed on the bottom surface (B) in a desired pattern (5), the cover film (4) includes a window (6) printed on the top surface, the window (6) is smaller than the cosmetic product (2) as shown in FIG. 3 so that the cosmetic product is fully displayed through the window (6).

Therefore, it would have been obvious to an ordinary skilled person in the art, at the time the invention was made, to have further modified the method and apparatus of Muchin by having

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provided a window of a desired pattern on the lamination material (70), as taught by Matsos, in order to fully display the cosmetic material in such the desired pattern.

With respect to Claims 22 and 26, the mount (52) is formed from plastic sheet (col. 2, lines 53-57).

With respect to Claim 23-25 and 27-29, the mount (52) disclosed in the Muchin reference includes any suitable material that can be formed into a plurality of cavities, and thermoplastic material such as polypropylene is one of such material. Therefore, it would have been obvious to an ordinary skilled person in the art, at the time the invention was made, to have modified the method and apparatus of Muchin by having used polypropylene material for the mount as a matter of engineering design choice. Since applicant does not offer any advantage regarding the thickness of polypropylene material; therefore, it would have been obvious to an ordinary skilled person in the art as a matter of engineering design choice to have utilized polypropylene material having thickness of 100-200 μ m.

With respect to Claim 30, the modified apparatus of Muchin in view of Gueret meets all of applicant's claimed subject matter but lacks the specific teaching of the filling device comprising a printing plate. However, Matsos further discloses an apparatus for screen printing powder-based cosmetic material including a screen printing press having a printing mesh and a squeegee for depositing the powder-based cosmetic material with desired shape and size on a film (4) (col. 2, lines 55-67). Therefore, it would have been obvious to an ordinary skilled person in the art, at the time the invention was made, to have further modified the apparatus of Muchin by having provided a screen printing press, as taught by Matsos, in order to deposit the powdery cosmetic material with desired shape and size onto the mount.

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With respect to Claims 31 and 34, the squeegee-like tool (77) comprised the filling device in the modified apparatus of Muchin is considered to be equivalent to a brush; wherein the brush (77) is moved by an inherent moving means (FIG. 3e).

With respect to Claim 32, although not expressly disclosed, the modified apparatus of Muchin inherently includes a supply means for supplying the powdery cosmetic material (75).

With respect to Claims 33-36, the modified apparatus of Muchin in view of Gueret and Matsos would have included a printing mesh and a brush (squeegee) that comprise the filling device, wherein the printing mesh and the brush operate in a well known manner and are movable by inherent moving means for moving the printing mesh and the brush toward and away from the mount that includes moving the printing mesh and the brush in an upward and downward direction.

Response to Arguments

8. Applicant's arguments filed May 28, 2004 with respect to the rejection of Claim 4 under 35 USC 112, first and second paragraphs have been fully considered but they are not persuasive. The specification broadly discloses a step of cutting the mount, but does not disclose and/or teach a step of specific step of cutting the mount on the concave portions. Note that, the present invention is concerned with a method and apparatus for producing cosmetic samplers and is not directed to a method and apparatus for manufacturing strip of cosmetic samplers and then scraping the manufactured strip cosmetic samplers. Therefore, Claim 4 and its dependent claims stand rejected under 35 USC 112, first and second paragraph.

9. Applicant's arguments with respect to the rejection of Claims 4 and 6 under 35 USC 103(a) have been considered but are moot in view of the new ground(s) of rejection.

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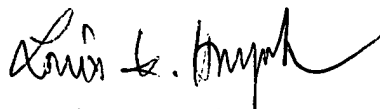
Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Louis K. Huynh whose telephone number is (703) 306-5694.

The examiner can normally be reached on M-F from 9:30AM to 5:00PM.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I. Rada can be reached on (703) 308-2187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Louis K. Huynh
Patent Examiner
Art Unit 3721

July 12, 2004